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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,537	07/20/2001	James M. Mathewson II	RSW920010103US1	1973

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EXAMINER	
CHEA, PHILIP J	

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,537	MATHEWSON ET AL.	
	Examiner	Art Unit	
	Philip J. Chea	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,9-12,14-20,22-24 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,9-12,14-20,22-24 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to an Amendment filed February 16, 2006. Claims 1-5,7,9-12,14-20,22-24 and 26 are currently pending. Any rejection not set forth below has been overcome by the current Amendment.

Response to Amendment

1. The declaration filed on February 16, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kasajima reference.

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kasajima reference to either a constructive reduction to practice or an actual reduction to practice. Although it appears that conception has been achieved prior to the Kasajima reference date. The exhibit provided with the declaration fails to show diligence during the period just prior to the reference date of the Kasajima reference May 23, 2001 up to the filing of the Subject Application on July 20, 2001. Please see MPEP 2138.06. A portion has been included below:

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading).

3. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Kasajima reference. The evidence only provides a general statement as to the invention being reduced to practice. The evidence lacks facts or proof that the invention was reduced to practice. Please see MPEP 715.07. A portion has been included below:

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the

exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5,7,9-12,14-20,22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5,325,310), herein referred to as Johnson, and further in view of Kasajima (US 2002/0178224).

As per claims 1,18,22, Johnson discloses marking a message, by a creator thereof (see column 5, lines 1-13);

sending the marked message from a computing device of the creator to a computing device of a recipient for whom the message was created such that after the marked message is received at the computing device of the recipient, the recipient will be forced to respond thereto (see column 6, lines 42-48); and

automatically receiving a reply from the recipient, sent from the computing device of the recipient to the computing device of the creator following the recipient's response thereto (see column 6, lines 42-48).

Although the system disclosed by Johnson shows substantial features of the claimed invention (discussed above), it fails to disclose marking the message as time-sensitive, automatically rendering the

message to the recipient, forcing the recipient to respond within a time period of the time-sensitivity, and receiving a response from the recipient within the time period of the time-sensitivity.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Johnson, as evidenced by Kasajima.

In an analogous art, Kasajima discloses a system for timely transferring electronic mail (see Abstract), wherein a message marked as time-sensitive (see paragraph [0053]) and automatically rendered to a recipient (see paragraph [0059]). Since Kasajima shows that the message can be automatically rendered once a time period has expired (see paragraph [0062]), it would be obvious to combine the teaching of Johnson of forcing the recipient to respond once that message is automatically rendered, and receive a response from the recipient as taught above by Johnson.

Given the teaching of Kasajima, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Johnson by employing a timely and automatic email rendering to a recipient, such as disclosed by Kasajima, in order to ensure that a recipient views a message.

As per claims 2,9, and 10, Johnson in view of Kasajima fail to disclose allowing the recipient to suppress (delay) the requiring step within the time period of sensitivity. Nonetheless, it would have been obvious to a person having ordinary skill in the art to allow the recipient to suppress (delay) the requiring step until a later time, wherein the later time is within the time period of sensitivity, if snoozing is allowed. The reason for doing so would be for the benefit of the recipient. If the message does not have to be immediately acknowledged, and he/she were in the process of responding to another important message, it would be beneficial to delay the requirement of the new message so they can finish with their current one. The motivation for allowing this to occur within the time period of sensitivity is because the message is only urgent within the time period.

As per claims 3,19, and 23, Johnson in view of Kasajima further disclose indicating by the creator an ending time for the time period of the time sensitivity of the message (see paragraph [0053]).

As per claim 4, Johnson in view of Kasajima further disclose indicating by the creator, a starting time for the time period of the time-sensitivity of the message (i.e. Kasajima sends the electronic mail message to indicate the start time and waits for a trigger to display the message, unless the expiration time has come and the display is forced).

As per claim 5, Johnson in view of Kasajima further disclose receiving the marked message at the computing device of the recipient (see Kasajima paragraph [0059]);

determining whether the time period of the time-sensitivity of the received message has been reached (see Kasajima paragraph [0062]); and

requiring the received message to be rendered to the recipient (see Kasajima paragraph [0059]), and forcing the recipient to respond thereto (see Johnson column 6, lines 42-48), within the time period of the time sensitivity if so (i.e. once the message is automatically rendered when time limit is expired, the recipient is forced to respond).

As per claims 7,20,24, Johnson in view of Kasajima disclose a system of improving electronic communications, comprising steps of:

receiving a plurality of electronic messages at a computer device of a recipient to whom the electronic messages are addressed (see Kasajima paragraph [0059]); and

evaluating the received messages for processing by the computing device, further comprising the steps of:

determining whether a selected one of the received electronic messages is time-sensitive (see Kasajima paragraph [0062]); and

requiring the selected one to be rendered to the recipient (see Kasajima paragraph [0059]), and forcing the recipient to respond thereto (see Johnson column 6, lines 42-48), within a time period of the time-sensitivity if the determining step has a positive result and the time period of the time-sensitivity has been reached but not exceeded (see Kasajima paragraph [0062]).

As per claim 11, Johnson in view of Kasajima further disclose sending a notification of the response to a computing device of a creator of the rendered selected one (see Johnson column 6, lines 42-48).

As per claim 12, although Johnson in view of Kasajima disclose determining whether processing of the rendered selected one is complete (see Johnson et al. columns 7 and 8, lines 63-68 and 1-4, where it is determined if an action taken by the recipient satisfies the response),

it fails to disclose remembering the rendered selected one for subsequent evaluation at a later time within the time period of sensitivity. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Johnson in view of Kasajima.

It would have been obvious to a person having ordinary skill in the art to be able to save the incomplete response to the message. Motivation for doing so is in case the recipient needs to leave and cannot finish the response immediately; it can be saved and finished at a later time within the period of time sensitivity while the message is still relevant.

As per claim 14, Johnson in view of Kasajima further disclose that the electronic messages are e-mail messages (see Kasajima paragraph [0059]).

As per claim 15, Johnson in view of Kasajima further disclose that the electronic messages are calendar events (see Kasajima paragraph [0059]).

As per claim 16, Johnson in view of Kasajima further disclose that the electronic messages are to-do items (see Kasajima paragraph [0059]).

As per claim 17, Johnson in view of Kasajima further disclose determining, when the selected one is time-sensitive and the time period of the time-sensitivity is approaching or has been reached but not exceeded, whether a hierarchy of event notification techniques has been defined for various intervals of the time-sensitivity, and if so, selecting a recipient notification technique which corresponds to an amount of time in the time period in addition to or instead of the step of requiring the selected one to be rendered to the recipient (see Kasajima Fig. 6a).

As per claim 26, Johnson in view of Kasajima further disclose automatically starting execution of an application for rendering the selected one, at the computing device of the recipient, if the execution of

the application is not currently started (see Kasajima Fig. 5b where TV is automatically turned on, and image is displayed);

automatically bringing a window rendered by the application to a foreground of a display of the computing device and making the window active (i.e.. it would have been obvious to display the email message and not allow the user to exit out until an appropriate action is taken Johnson 4, lines 28-32);

automatically rendering the selected one in the active window (see Kasajima Fig. 5b); and

requiring the recipient to take action with the selected one before performing any other tasks with the application (see Johnson 4, lines 28-32).

Response to Arguments

6. Applicant's arguments with respect to claims 2,9,10 have been considered but are moot in view of the new ground(s) of rejection.

(A) Applicant request the Examiner cite prior art to teach the snooze feature.

In considering (A), Johnson in view of Kasajima do not expressly disclose indicating by the creator, that snoozing is allowed by the recipient of a message, such that the recipient will be allowed to temporarily delay a response. However, Johnson discloses that a sender can remove a persistent reply setting (see column 7, lines 21-40). At the time of the invention, a person skilled in the art would have found it obvious to allow a recipient to snooze for a message and delay the reponse by removing a persistent reply setting, in order to give the recipient an opportunity to address other matters that might be more urgent. In considering temporarily delaying the response within the time period of time-sensitivity. The teachings provided by Kasajima about receiving a response from the recipient within the time period of time-sensitivity would be make it obvious to a person skilled in the art that a delay is only temporary up until the time-period of sensitivity has expired.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC 5/4/06

KRISNA LIM
PRIMARY EXAMINER